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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/132,593	08/11/1998	ASGEIR SAEBO	21440/9015	9659
23535	7590	02/11/2004	EXAMINER	
MEDLEN & CARROLL, LLP 101 HOWARD STREET SUITE 350 SAN FRANCISCO, CA 94105			WANG, SHENGJUN	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/132,593

Applicant(s)

SAEBO ET AL.

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date May 30, 2003
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

Receipt of applicants' amendments and remarks submitted October 27, 2003 is acknowledged.

#### *Claim Rejections 35 U.S.C. § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. (US 5,554,646 of record) in view of applicants' disclosure at page 11, line 13-25 in the specification, Cain et al. (WO 97/18320, IDS April 13, 2000), and Chin et al. (IDS, November 23, 1999), in further view of Baltes et al. (US Patent 3,162,658, IDS May 23, 1999) for reasons set forth in the prior office action.

#### *Response to the Arguments*

Applicants' remarks submitted May 6, 2003 have been fully considered, but are not persuasive for reasons discussed below.

Applicants assert that the prior office action has not addressed all the arguments presented in the response dated May 6, 2003, the arguments are: *In re Michalek* does not applied to the fact of present case; evidence presented by applicants has not been considered; and reasonable expectation of success. However, in the response dated May 6, 2003, applicants merely stated *In re Michalek* is decision is more than 50 years old and is conflict with current case law and PTO practice, and did not point out what the conflict is. Applicants confuse

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“persuasive” with “considered” As stated in prior office action, all the arguments presented by applicants, including the evidence submitted with the declaration, have been fully considered, but are found not persuasive. The examiner has not ignored applicants’ evidence. All the facts, including applicants’ evidence. When applicants’ evidence is not consistent with the teaching from prior art, *In re Michalek* is properly applied. The examiner fails to see any conflict between the *In re Michalek* decision and current case law or current PTO practice.

3. As stated in the prior office action, “the declaration fails to establish the fact that the conjugated linoleic acid disclosed by Cook or Cain as recited in the prior office action containing more than 2% of the isomers identified in the claim herein. Particularly, applicant generated data, proffered to obviate prior art teachings, lacks the probative force accorded data generated by independent, disinterested parties. It is well settled patent law "that it is not a difficult matter to carry out a process in such a fashion that it will not be successful and, therefore, the failures of experimenters who have no interest in succeeding should not be accorded great weight" *In re Michalek*, 74 USPQ 108, at 109 citing *Bullard Company et al v. Coe*, 147 F.2d. 568, 64 USPQ 359.” Applicants have argued that the cited references do not teaches each element of the claims, particularly, the CLA compounds, including those disclosed in the cited prior art, inherently comprising more than 2% of trans, trans, 8, 10 and 11, 13 octadecadienoic acids or derivatives. The arguments are not convincing. Particularly, the presence of trans trans isomers is well known in the art, and is acknowledged by Cain (page 1, lines 15-25). However, Cain et al. do not disclose the presence of trans isomers in their CLA composition. The examiner is not convinced by the assumption that Cain et al. cannot detect the trans trans isomers, or simply ignores the presence of the isomers. The evidence provided with the declaration has been fully

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evaluated against the cited reference. Applicants provided results contrary to the references, making assumption without factual support. The examiner has not stated (and does not intend to) that applicants committed fraud. The examiner merely states that the evidence are not convincing. Applicants' experiments provide a results contrary to those disclosed in the prior art is not convincing.

4. As to the applicants' remarks about assumption and fact, note applicants' arguments at least based on two assumption. First, applicants assume that Cain's statements that the CLA in the composition is composed of 48.9 % of c9, t11, 51.1 % of t10, c12 linoleic acid or their esters is wrong and Cain completely ignores the other CLA isomers in his analysis. Second, applicants assume that the experiments described in the declaration would exactly duplicate the composition obtained by Cain et al.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

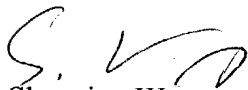
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (571) 272-0632 after February 3, 2004). The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Primary Examiner

  
Shengjun Wang

February 7, 2004